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In re Application of
WITTWER, Bruno
Application No.: 09/831,615
PCT No.: PCT/AU99/00992
Int. Filing Date: 10 November 1999
Priority Date Claimed: 10 November 1998
Attorney Docket No.: 19724-87004
For: PISTON PUMP

**DECISION ON SECOND
RENEWED PETITION
UNDER 37 CFR 1.47(b)**

This decision is in response to applicant's second "Renewed Petition Under 37 CFR §1.47(b)," ("2d.Ren.Pet.") filed 10 September 2002.

BACKGROUND

On 10 June 2002, a decision dismissing applicant's petition under 37 CFR 1.47(b) was mailed because applicant failed to satisfy items (2), (4) and (5).

On 10 September 2002, applicant submitted the second renewed petition which was accompanied by various documents numbered 1-11.

DISCUSSION

Applicant failed to satisfy items (2), (4), and (5) of 37 CFR 1.47(b) with the first two petitions.

Item (2) of 37 CFR 1.47(b)

The 37 CFR 1.47(b) applicant initially failed to show that Mr. Wittwer was presented with a complete copy of the application, including claims, specification and drawings. In the first renewed petition, applicant sufficiently demonstrated that Mr. Wittwer was presented with a complete copy of the application. However, the 37 CFR 1.47(b) applicant did not indicate what response, if any, the nonsigning sole inventor had to the documents submitted on 05 April 2002. In addition, the 37 CFR 1.47(b) applicant did not provide other documentary evidence requested such as the email from Mr. Wittwer dated 09 July 2001.

In the second renewed petition, the 37 CFR 1.47(b) applicant included the email

dated 09 July 2001 from Mr. Wittwer and also states that “[t]o date, Mr. Wittwer has not responded to the mailing set forth in paragraph 14 [the documents mailed 05 April 2002].” 2d.Ren.Pet. at ¶ 16. The 37 CFR 1.47(b) applicant concludes that “based on the fact that Mr. Wittwer has demanded more money, desires to compete with Solar Energy Systems, and his lack of response from a registered letter sent over three months ago clearly demonstrates his refusal to sign the declaration for the above-captioned patent application.” Id.

This explanation and documentary evidence is sufficient to meet item (2).

Item (4) of 37 CFR 1.47(b)

Counsel states in the last page of the second renewed petition that “[e]nclosed along herewith is a Power of Attorney and a newly executed Combined Declaration and Power of Attorney form executed by the undersigned on behalf of Wittwer.” However, this declaration was not included in any of the documents filed with the second renewed petition in Exhibits 1 -11.

Since a new declaration was not provided, item (4) is still not satisfied.

It is also noted that the declaration previously filed by the 37 CFR 1.47(b) applicant on 26 April 2002 still does not meet the requirements of the MPEP discussed in the prior decision.

Item (5) of 37 CFR 1.47(b)

In the second renewed petition, the 37 CFR 1.47(b) applicant included a declaration signed by Mr. Maslin who declares that “the above-captioned international application PCT/AU99/00992, and the above-captioned application do not include any new matter not contemplated by the two priority patent applications of paragraph 6.”

The 37 CFR 1.47(b) applicant must demonstrate that they have sufficient proprietary interest in the above-captioned application by proving that (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application. See § 409.03(f) MPEP (8th Edition).

After reviewing the Agreement between SES and Mr. Witwer again, the declarations of Mr. Maslin, as well as the emails of Mr. Wittwer dated 09 July 2001, 16 July 2001 and 14 August 2001, the letters of Greg Allen, the letters of B/W Solar by Mr. Wittwer, and the fact that this dispute concerns the law of a foreign jurisdiction, it is not obvious that the 37 CFR 1.47(b) applicant has demonstrated the required proprietary interest.

Therefore, the 37 CFR 1.47(b) applicant must provide an appropriate legal

memorandum to the effect that an Australian court of competent jurisdiction would by the weight of authority in Australia award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of this conclusion should be made of record by an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with Australian law. A copy of any Australian statute or any Australian court decision relied on to demonstrate sufficient proprietary interest should be made of record.

For this reason, item (5) is still not satisfied.

CONCLUSION

Since the 37 CFR 1.47(b) applicant has not met the requirement of items (4) and (5) of 37 CFR 1.47(b), applicant's second renewed petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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